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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,202	12/10/1999	YUKIKAZU MORI	2271/60882	9787
7590	01/23/2004		EXAMINER	
IVAN S KAVRUKOV ESQ COOPER & DUNHAM LLP 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			LEE, TOMMY D	
			ART UNIT	PAPER NUMBER
			2624	
			DATE MAILED: 01/23/2004	

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/459,202	MORI, YUKIKAZU
	Examiner Thomas D. Lee	Art Unit 2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 November 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-31 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) Interview Summary (PTO-413) Paper No(s) _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Response to Amendment

1. This Office action is responsive to applicant's AMENDMENT, filed November 5, 2003. Claims 1-31 are pending.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,052,445 (Bashoura et al.).

Regarding claim 1, Bashoura et al. teach a network facsimile device for communicating in at least one of a plurality communication modes for transmitting designated image information to a designated destination, said device comprising: input means for operator input of information identifying a plurality of destination addresses, including for each destination a plurality of address information respectively corresponding to said plurality of communication modes, and for designating one address among said plurality addresses (column 3, line 63 – column 4, line 7; column 4, lines 15-20 (programming a table to store information inherently requires an operator to input the information intended to be stored)); and address information registering means for registering a plurality of address information respectively corresponding to said plurality of communication modes, input by the operator through said input means, for each destination (column 4, lines 8-20).

Regarding claim 9, Bashoura et al. teach a network facsimile device comprising: Internet image information communicating means for performing communication of image information through the Internet (column 2, lines 51-56); and public network image information communication means for performing communication of the image information through a public network, wherein said Internet image information communication means and said public network image information communicating means communicate information to a plurality of designated destinations (column 2, lines 56-61); input means for inputting information identifying a plurality of addresses and for designating one address among said plurality of addresses (column 3, line 63 – column 4, line 7); and address information registering means for registering a plurality of address information respectively corresponding to said Internet image information communicating means and public network image information communicating means, for each designated destination (column 4, lines 8-20).

Regarding claims 10 and 11, Bashoura et al. teach a network facsimile device comprising: electronic-mail type Internet image information communicating means for performing communication of the image information through the Internet by use of electronic mail (column 4, lines 27-38); real-time type Internet image information communicating means for performing communication of image information through said Internet in real time (column 4, lines 21-26, 34-38); and public network image information communicating means for performing communication of image information through a public network (column 2, lines 56-61), wherein either one of said electronic-mail type Internet image information communicating means, said real-time type Internet

image information communicating means, and said public network image information communicating means communicate information to a plurality of designated destinations addresses (column 4, line 43 – column 5, line 13); and input means for inputting information identifying a plurality of addresses and for designating one address among said plurality of addresses (column 3, line 63 – column 4, line 7); and address information registering means for registering a plurality of address information respectively corresponding to said electronic-mail type Internet image information communicating means, said real-time type Internet image information communicating means, and said public network image information communicating means, for each designated destination (column 4, lines 8-20). Said plurality of registered address information include an e-mail address for use by said electronic-mail type Internet image information communicating means, an IP address for use by said real-time type Internet image information communicating means, and a telephone number for use by said public network image information communicating means (Fig. 4).

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 2, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. as applied to claim 1 above, and further in view of U.S. Patent 6,437,871 (Yuki).

Bashoura et al. do not teach display means, wherein, when said input means is repeatedly operated at the time of designating the address, a plurality of address

information registered are changed over and viewed on said display means in order, as recited in claim 2, or one-touch dial means for enabling a large number of addresses to be registered and to designate the one address by operating the one-touch dial means, as recited in claims 5 and 6. Yuki teaches a facsimile apparatus having a display means for displaying a plurality of registered address information stored in one-touch dial memory (column 5, lines 51-57; column 6, lines 54-59). When one of the destinations is specified by operation of the panel operation portion, a copy operation begins (column 5, lines 56-60; column 6, lines 59-64). By providing a one-touch dial operation, a user may save time in dialing numbers that are frequently used, since only one key corresponding to the telephone number or IP address need be pressed.

Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al., by providing a one-touch dial memory such as taught by Yuki. Repeated operation of input means is merely a scrolling operation for changing addresses or modes of operation on a display, which is well known in the art.

6. Claims 12-14, 21/(9-14) (claim 21 as depending from any one of claims 9-14) and 25/14 rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. as applied to claims 9-11 above, and further in view of Yuki.

Claims 12-14 each recite the display means of claim 2, and claims 21 and 25 each recite the one-touch dial means of claims 5 and 6, and thus are rejected for the reasons set forth above.

Art Unit: 2624

7. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. as applied to claim 1 above, and further in view of U.S. Patent 5,381,527 (Inniss et al.).

Regarding claim 3, Bashoura et al. do not teach setting each of a plurality of address information registered by said address information registration means with a transmission priority indicating an order in which communication modes are to be used for transmitting the designated image information to the designated destination, as recited in claim 3. Inniss et al. teach a system for efficient message distribution, wherein methods of communicating messages are prioritized (column 3, line 33 – column 4, line 5). By prioritizing the communication modes, the transmitting of any type of message may be performed with greater efficiency. A user may know which destinations are capable of operating under certain modes of communication, and may prioritize based on such knowledge so as to avoid possible errors in transmission. Thus, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by providing means for setting a priority order for communicating messages, such as taught by Inniss et al.

Claim 4 further recites repeatedly operating the same key at the time of selecting the address, thereby changing over and selecting plural address information registered on said key in accordance with said transmission priority order. As mentioned above with respect to claim 2, repeated operation of input means is merely a scrolling operation for changing addresses or modes of operation on a display, which is well known in the art. Providing a key for changing and selecting address information

according to a priority order would have been an obvious modification for one of ordinary skill in the art, for it allows a user to save time in changing priorities for each destination.

8. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. as applied to claims 9-11 above, and further in view of Inniss et al.

Claims 15-17 each recite the setting means of claim 3, and are thus rejected for the reasons set forth above.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. in view of Inniss et al. as applied to claim 4 above, and further in view of Yuki.

Claim 8 recites the one-touch dial means of claims 5 and 6. As mentioned above, Yuki teaches a facsimile apparatus having a display means for displaying a plurality of registered address information stored in one-touch dial memory (column 5, lines 51-57; column 6, lines 54-59). When one of the destinations is specified by operation of the panel operation portion, a copy operation begins (column 5, lines 56-60; column 6, lines 59-64). By providing a one-touch dial operation, a user may save time in dialing numbers that are frequently used, since only one key corresponding to the telephone number or IP address need be pressed. Therefore, it would have been obvious for one of ordinary skill in the art to modify the combined teaching of Bashoura et al. and Inniss et al., by providing a one-touch dial memory such as taught by Yuki.

10. Claims 18-20, 22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al.

As mentioned above with respect to claim 2, Bashoura et al. do not teach repeatedly operating the same key at the time of designating the address, thereby changing over and selecting, in order, a plurality of address information registered in said key (claims 18-20 do not recite display means, and is thus not rejected in view of Yuki). However, repeated operation of input means is merely a scrolling operation for changing addresses or modes of operation on a display, which is well known in the art. Providing a key for changing and selecting address information in order would have been a obvious modification for one of ordinary skill in the art, for it allows a user to save time in changing address information. Accordingly, claims 18-20 are rejected for the reasons set forth above with respect to claim 2.

Claim 22 recites the features of above-rejected claim 10, and further recites the repeated operation of input means similarly recited in claim 20, and is thus rejected, along with corresponding method claim 26, for the reasons set forth above.

11. Claims 21/(18-20), 25/22 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. as applied to claims 18-20, 22 and 26 above, and further in view of Yuki.

As mentioned above, claims 21 and 25 recite the one-touch dial means of claims 5 and 6, and thus are rejected for the reasons set forth above. Claim 31 also recites the one-touch dial means of claims 5 and 6, and thus is rejected as well.

12. Claims 23, 24, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. in view of Inniss et al.

Claim 23 recites the features of above-rejected claim 10, and further recites registering respective transmission priority orders for each of said mail address, said IP address, and said telephone number; wherein either one of said electronic-mail type Internet image information communicating means, said real-time type Internet image information communication means, and said public network information communicating means is selected in accordance with the transmission priority order respectively registered with said mail address, said IP address, and said telephone number, for image information transmission to the address selected by operation of said input means. As mentioned above with respect to claim 3, Inniss et al. teach a system for efficient message distribution, wherein methods of communicating messages are prioritized (column 3, line 33 – column 4, line 5). By prioritizing the communication modes, the transmitting of any type of message may be performed with greater efficiency. A user may know which destinations are capable of operating under certain modes of communication, and may prioritize based on such knowledge so as to avoid possible errors in transmission. Thus, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by providing means for setting a priority order for communicating messages, such as taught by Inniss et al. Accordingly, device claim 23, as well as corresponding method claim 27, is rejected.

Claim 24 recites most of the features of claim 23, and further recites repeated operation of input means, thereby changing over and selecting plural addresses in accordance with a transmission priority order. As mentioned above with respect to claim 4, providing a key for changing and selecting address information according to a

priority order would have been a obvious modification for one of ordinary skill in the art, for it allows a user to save time in changing priorities for each destination. Accordingly, device claim 24, as well as corresponding method claim 28, is rejected.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. in view of Inniss et al. as applied to claim 3 above, and further in view of Yuki.

Claim 7 recites the one-touch dial means of claims 5 and 6. As mentioned above, Yuki teaches a facsimile apparatus having a display means for displaying a plurality of registered address information stored in one-touch dial memory (column 5, lines 51-57; column 6, lines 54-59). When one of the destinations is specified by operation of the panel operation portion, a copy operation begins (column 5, lines 56-60; column 6, lines 59-64). By providing a one-touch dial operation, a user may save time in dialing numbers that are frequently used, since only one key corresponding to the telephone number or IP address need be pressed. Therefore, it would have been obvious for one of ordinary skill in the art to modify the combined teaching of Bashoura et al. and Inniss et al., by providing a one-touch dial memory such as taught by Yuki.

14. Claims 21/(15-17) and 25/(15, 23, 24) are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. in view of Inniss et al. as applied to claims 15-17, 23 and 24 above, and further in view of Yuki.

As mentioned above, claims 21 and 25 each recite the one-touch dial means of claims 5 and 6, and thus are rejected for the reasons set forth above.

15. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. in view of Inniss et al. as applied to claims 27 and 28 above, and further in view of Yuki.

Claims 29 and 30 each also recite the one-touch dial means of claims 5 and 6, and thus are rejected as well, for the reasons set forth above.

Response to Arguments

5. Applicant's arguments filed in response to the rejections of claims 1-31 under 102(e) or 103(a) as set forth in the prior Office action dated August 13, 2003 have been fully considered but they are not persuasive.

In response to the above rejections, applicant amended claim 1 to indicate that information identifying a plurality of destination addresses, including for each destination a plurality of address information respectively corresponding to a plurality of communication modes, are input by an operator through the recited input means. Regarding Bashoura et al., applicant states that an operator is allowed to enter only a telephone number, and the fax director is a separate device which is connected to the conventional fax machine (page 19, lines 14-17 of AMENDMENT). Contrary to applicant's assertion, Bashoura et al. allows for operator input of destination address information. Such information, stored in telephone number table 7, is generated and maintained, "using well-known programming techniques. When it is known that a potential fax recipient has the ability to receive a fax over the Internet, the recipient's telephone number and his receiving Internet address is stored in the table 7." (column 4, lines 15-20) Programming a table to store information inherently requires an operator to

input the information intended to be stored. As for the fax director being a separate device connected to the conventional fax machine, it is known that a device such as the system taught by Bashoura et al. can be made up of separate components connected to each other. Applicant does not claim elements which are provided in a single housing, so claim 1, as broadly recited, reads on Bashoura et al.

Applicant further states that Bashoura et al. does not disclose or suggest a network facsimile device comprising the elements recited in claim 1 (page 19, line 18 – page 20, line 2; and page 20, line 18 – page 21, line 3 of AMENDMENT). Apart from the operator input of destination address information, applicant's statement amounts to a general allegation that the claim 1 defines a patentable invention without specifically pointing out how the language of the claim patentably distinguishes it from the reference.

Applicant mentions the Yuki and Inniss patents (page 20, lines 3-17 of AMENDMENT). However, applicant does not indicate why any of the claims should be allowable over these references, whether alone or in combination with Bashoura et al.

Applicant states independent claims 9, 10, 22-24 and 26-28 are patentable for similar reasons as indicated for claim 1 (page 21, lines 4-7 of AMENDMENT). However, claim 1 is not patentable, for the reasons mentioned above. Thus, this argument is not considered persuasive.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (703) 305-4870. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Thomas D. Lee
Primary Examiner
Art Unit 2624

Application/Control Number: 09/459,202
Art Unit: 2624

Page 14

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January 22, 2004